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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,430	03/01/2004	Carl Frederick Behr	38-21(52258)C	9938

27161 7590 06/29/2005

MONSANTO COMPANY  
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EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT PAPER NUMBER

1637

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/790,430

Applicant(s)

BEHR ET AL.

Examiner

Suryaprabha Chunduru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7, 13 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 13, 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Applicants' response to the office action filed on April 22, 2005 has been entered.

**Status**

2. Claims 7, 13, are amended. Claims 1-6, 8-12, 14-15 are cancelled. New claims 17-19 are added. Claims 7, 13, 16-19 are pending. All arguments have been fully considered and thoroughly reviewed, and are deemed persuasive in part for the reasons that follow. This action is made FINAL necessitated by amendment.

***New rejections necessitated by amendment***

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

C. Claims 7 and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Barry et al. (USPN. 6,448,476).

Barry et al. teach a pair of DNA molecules of claim 7 comprising sufficient length of contiguous nucleotides of SEQ ID No. 7 (see sequence alignment for a sufficient length of contiguous nucleotides of SEQ ID No. 7 with a fragment position 1-202 of SEQ ID NO. 27 (first DNA molecule) and with a fragment 2239-2378 of SEQ ID No. 27).

With regard to claim 16, Barry et al. also teach a kit comprising DNA molecules (see col. 7, line 1-10).

With regard to claim 17-19, Barry et al. teach that the pair of DNA molecules are at least 18-30 nucleotides in length (see sequence alignment for a sufficient length of contiguous nucleotides of SEQ ID No. 7 with a fragment position 1-202 of SEQ ID NO. 27 (first DNA molecule) and with a fragment 2239-2378 of SEQ ID No. 27).

As stated in MPEP 2112- Products of identical chemical composition can not have mutually exclusive properties. "A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Since the DNA molecules as disclosed by Barry et al. have identical composition, the said molecules would have similar properties (function as probes) as claimed. Thus the disclosure of Barry et al. meets the limitations in the instant claims.

D. Claims 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Marra et al. (EST, 1996).

Note: the following rejection is based interpreting the claim selected from the group consisting of" phrase as open language "comprising" format, that is, sequence comprising the claimed SEQ ID NO.11.

Marra et al. teach a DNA molecule of claim 13 comprising DNA molecule having absolute homology with the claimed of SEQ ID No. 11 (see sequence alignment for SEQ ID No. 11). Thus the disclosure of Marra et al. meets the limitation in the instant claim.

***Response to arguments:***

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4. With regard to the rejection under 35 USC 101, Applicants' arguments and amendment are fully considered and found persuasive. The rejection is withdrawn in view of the amendment.

5. With regard to the rejection less than 35 USC 112, second paragraph, Applicants' amendment and arguments are fully considered and found not persuasive. The amendment reciting DNA molecule selected from the group of sequences consisting of ' did not change the meets and bounds of the claims. And it is unclear whether the DNA molecule consists of a sequence of SEQ. ID. No. or the DNA molecule comprises the sequence of the SEQ ID NO. Therefore the rejection is maintained.

6. With regard to the rejection under 35 USC 102(b) as anticipated by sigma Catalog, Applicants' amendment and the arguments are fully considered and found persuasive in view of the amendment.

7. With regard to the rejection under 35 USC 102(b) as anticipated by McElory et al. (USP. 5,641,876), Applicants' amendment and the arguments are fully considered and found persuasive in view of the amendment.

8. With regard to the rejection under 35 USC 102(e) as anticipated by Barry et al. Applicants' arguments and amendment are fully considered and found not persuasive. Applicants' argue that a first DNA of the sequence of SEQ ID No. 7 corresponding to the SEQ ID No. 27 of Barry et al. is not from the maize genomic flanking DNA sequence as amended in the instant claim 7 and thus Barry et al. does not anticipate claim 7. Applicants' arguments are fully considered and found not persuasive because as stated in MPEP 2112- Products of identical chemical composition can not have mutually exclusive properties. "A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the

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properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). In the instant context, a pair of DNA molecules of at least 11 nucleotides in length correspond to the sequences taught by Barry et al. Thus the contiguous stretch of complementary sequences (at least 11 nucleotides in length) inherently have the similar property as claimed, that is, the sequences taught by Barry will function as DNA probes and primers. Applicants further argue that Barry et al. teach a kit comprising DNA molecules as well as other reagents that are used to identify AMPA acyltransferase gene sequences and the claimed SEQ ID Nos. 7 and 8 do not comprise AMPA acyltransferase thus Barry et al. does not anticipate claim 16. Applicants' arguments are fully considered and found not persuasive. The kit of Barry et al. comprises a DNA molecule of sufficient length of contiguous nucleotides that are complementary to SEQ ID NO. 7, which meets the limitations in the claim 16 because the instant claim requires sufficient length of contiguous nucleotides that are complementary to SEQ ID No. 7 and not the whole sequence of SEQ ID No. 7. Further as discussed above the sufficient length of contiguous nucleotides act as primers and probes since they are complementary to the sequences taught by Barry et al. Therefore the rejection is maintained herein and re-written to include the limitations of the new claims.

9. With regard to the rejection under 35 USC 102(b) as anticipated by Marra et al., Applicants arguments are fully considered and found not persuasive. Applicants argue that the claim 13 is amended to recite a closed language. Applicants' arguments and amendment are fully considered and found not persuasive, because as discussed above the rejection under 35 USC 112, second paragraph is not obviated by the amendment and the claim reciting "selected from the group of

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sequences consisting of' is considered as comprising format and hence the sequence taught by Marra et al. meets the limitations in the instant claim and the rejection is maintained herein.

***Conclusion***

No claims are allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

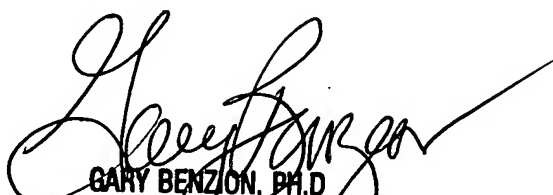
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M , Mon - Friday,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-573-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Surya Prabha Chunduru  
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Art Unit 1637

  
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